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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 09/955,799 | 09/18/2001 | Peter A. Thayer | 79-00-002 (014208.1393) | 1048 |
| 5073 | 7590 | 07/27/2005 | EXAMINER | |
| BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980 | | | O'CONNOR, GERALD J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3627 | |

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/955,799 | Thayer |
| | Examiner O'Connor | Art Unit 3627 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on May 9, 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-45 is/are pending in the application.
 - 4a) Of the above claim(s) 1-20 and 31-45 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 21-30 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on September 18, 2001 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment and arguments filed by applicant on May 9, 2005 in reply to the previous Office action, mailed February 8, 2005.

2. The amendment of claim 21 in the reply filed by applicant on May 9, 2005 is hereby acknowledged.

Election/Restriction

3. Claims 1-20 and 31-45 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed November 17, 2004.

Claim Rejections - 35 USC § 101

4. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 21-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21-30 are drawn merely to the production and/or manipulation of non-functional descriptive material, therefore effecting no "useful, concrete, and

tangible result." Note that claims 21-30 read, for example, merely on a pictorial/graphic image of a flowchart, or, on a written/textual description of an algorithm, either of which document being printed on a sheet of paper/media). It has been held that such claims, even if the non-functional descriptive material is claimed in combination with a computer-readable medium (which claims 21-30 are not), are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea. *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in-
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
 - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 21-30 are rejected under 35 U.S.C. 102(a) as being anticipated by the admitted prior art, as described in the background of the invention on page 2 of the specification.

The invention, *as disclosed*, is an automated means for accomplishing the same results as had heretofore been accomplished by manual means. The conventional manual method is described in the background of the invention on page 2 of the specification. However, the invention, *as claimed*, requires no automated means, and thus reads on the underlying conventional process, by which it is therefore anticipated.

Response to Arguments

8. Applicant's arguments filed May 9, 2005 have been fully considered but are not persuasive.

9. Regarding the argument that the claims comprise statutory subject matter because "Claim 21 is not directed to production and/or manipulation of non-functional descriptive material" because "Non-functional descriptive material [includes] mere arrangements or compilations of facts or data that are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer," the claims indeed are non-statutory because the claims indeed comprise non-functional descriptive material since the claims indeed read on mere arrangements or compilations of facts or data that are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer.

10. Regarding the argument *vis-à-vis* Lowry, the rejection points out that applicant's claims do not require that the recited non-functional descriptive material is embodied in a computer-readable medium. Lowry teaches that non-functional descriptive material is non-statutory, and that it is *still* non-statutory even if stored in a computer-readable medium.

11. Regarding the argument concerning consideration of all of applicant's claim terms, claim terms that have no meaning, or have a meaning that cannot be understood, cannot be considered. Since there is no inherent limit on the range of a transmission, applicant's referral to "the range" of something that does not necessarily have a range makes no sense, thus cannot be considered.

12. Regarding the argument that the Background section of the specification involves only examples with human interaction, understand that the rejection contemplates human interaction. For example, "Hey Earl, we got any of them 123s?" (transmission of an enumeration query having a broadcast range). "I dunno, I'll call Hank and ask..." (facilitating transmission of the query). "Yep, Hank says we got twenty out back." (message including data regarding an inventory object beyond the broadcast range of the transmission). Etcetera.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to the disclosure.

14. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC
July 22, 2005



Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627